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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|--------------------------|------------------|
| 09/972,812 | 10/05/2001 | Thomas Clement Barthel | CMS-012 | 6757 |
| 7590 | 01/05/2004 | | EXAMINER | |
| OLSON & HIERL, LTD. 36th Floor 20 North Wacker Drive Chicago, IL 60606 | | | FLANAGAN, BEVERLY MEINDL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |
| | | | DATE MAILED: 01/05/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/972,812 | BARTHEL ET AL. |
| | Examiner | Art Unit |
| | Beverly M Flanagan | 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-31,33-39,41 and 42 is/are rejected.
- 7) Claim(s) 3,32 and 40 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 May 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2003 (which is a copy of the after final amendment submitted on September 23, 2003) has been entered.

Withdrawal of Previous Rejections

The prior art rejections previously set forth in the Office actions of Paper Nos. 6 and 9 are hereby withdrawn.

The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-17, 19-31 and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullard (U.S. Patent No. 5,318,008).

In regard to claims 1, 2, 6, 12, 19, 24, 30, 31 and 37, Bullard teaches a cavitoscope 20 comprised of a flexible section (designated by boot 52 in Figure 1) that is bendable between a relaxed configuration and a strained configuration as the cavitoscope 20 is guided through a body lumen (see Figures 3 and 4). Extending through the flexible section are an optical channel 30 and a light transmitting channel 25, where both channels can carry fiber optics (see col. 3, lines 41-49). A distal end 24 is connected to the flexible portion and, when the flexible portion is operated to the strained or bent position, the distal end 24 is offset laterally or angularly disposed from the flexible portion, at an acute angle relative to the flexible portion (see Figure 4). Bullard does not specifically disclose whether distal end 24 is substantially fixedly rigid. However, it is well known in the art of endoscopes to form the distal end piece of the endoscope from a substantially fixedly rigid material, as the distal end piece contains the termination ends of optical transmission medium (such as the viewing lens 34 of Bullard), as the distal end piece is instrumental in the insertion of the endoscope into the body cavity (and thus requires some rigidity to enable the insertion) and as the distal end piece in Bullard is remotely moveable by the operator via the flexible section (i.e., if the distal end piece were flexible, transmission of movement of the flexible section to the distal end piece would not be as easily accomplished. Accordingly, it is the examiner's opinion that the distal end 24 of Bullard is inherently substantially fixedly

rigid. **With further regard to claims 19 and 30**, col. 5, lines 15-20 of Bullard disclose the spring-back action of the distal end 24 in response to actuation of a button 44.

In regard to claims 4 and 38, Bullard is silent as to the degree or amount of offset of the distal end 24 from the flexible portion. However, it is the examiner's opinion that the cavitoscope 20 of Bullard is capable of having the distal end 24 offset from the flexible portion in the range of 1 mm to 5 mm, as the flexible portion is adjustable (see col. 5, lines 1-19). **In regard to claims 5 and 39**, Bullard is silent as to the diameter of distal end 24. However, it is the examiner's opinion that the distal end 24 of Bullard is capable of being formed with a diameter of about 2 mm to about 5 mm, as endoscopes with diameters in this range are well known in the art. **In regard to claims 7-10**, Bullard teaches that boot 52 is formed form a flexible resilient material such as polymer (see col. 5, lines 20-25). As noted above, it is the examiner's opinion that the distal end 24 of Bullard is inherently substantially fixedly rigid, which could include metal materials. However, the distal end 24 could also be formed from a polymer material, albeit a substantially rigid polymer material. Accordingly, the flexible portion and the distal end 24 of Bullard could comprise either substantially dissimilar or substantially similar materials. **In regard to claim 11**, Figures 3 and 4 of Bullard show that the flexible portion and the distal end 24 are, as broadly as claimed, integrally constructed. **In regard to claims 13-17, 20-23, 25-29 and 33-36 and with further regard to claims 19 and 30**, Bullard teaches that the distal end 24 has an angle of deflection of about 45 degrees, however, any suitable angle of deflection can be provided (see col. 5, lines 5-9). **In regard to claim 18**, Bullard discloses alternatively affixing a viewing lens or a

video camera affixed at the proximal end of the cavitoscope 20 for viewing of images received at the distal end 24 via the lens 34 (see col. 1, lines 19-30).

In regard to claim 41, it is the examiner's opinion that the cavitoscope 20 of Bullard is capable of being used to perform the method steps outlined in claim 41 of the instant invention, including the step of inserting the cavitoscope 20 into an endotracheal tube with the distal end 24 offset in the direction of curvature of the endotracheal tube and advancing the cavitoscope 20 within the endotracheal tube such that the distal end 24 is offset from the endotracheal tube. **In regard to claim 42**, see the above rejection for claim 1.

Allowable Subject Matter

Claims 3, 32 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should note the following prior art reference disclosing endoscopes having distal ends that are offset or angled from the main body: Bullard, U.S. Patent No. 4,086,919; Bullard et al., U.S. Patent No. 5,003,963; Bullard, U.S. Patent No. 5,842,973 and Zimmer, U.S. Patent No. 3,918,439.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Beverly M. Flanagan
Primary Examiner
Art Unit 3739
